

REMARKS

In response to the Notice of Non-Compliant Amendment mailed February 27, 2009, the Assignee respectfully requests reconsideration based on the above amendments and on the following remarks.

Claims 1, 3, 11, 13, 19, and 21-23 are pending in this application. Claims 2, 12, and 20 were previously canceled, and claims 4-10, 14-18 were withdrawn by restriction.

Objection to the Drawings

The Office objected the drawings as failing to show every claimed feature. The Office, in particular, objects to the claimed longitudinal portion with a spiral groove and an end portion. These features, however, have been canceled from the claims, so the objection is moot.

Objection to Amendment

The Office objected to the amendment filed June 6, 2008 for introducing new matter. The Office, in particular, finds no support for a convexly shaped bottom floor of each groove. These features have been canceled.

Rejection of Claims Under 35 U.S.C. § 112, first paragraph

Claims 1, 3, 11, 13, 19, and 21-23 were rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. The Office, in particular, finds no support for a convexly shaped bottom floor of each groove. These features have been canceled, so the rejection is moot.

Rejection of Claims Under 35 U.S.C. § 112, second paragraph

Claims 1, 3, 11, 13, 19, and 21-23 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Office, in particular, finds it unclear how the spiral grooves interact with the end portion. The spiral grooves have been canceled from the claims, so the rejection is moot.

The Office also finds it unclear what is meant by a “mechanism attaching a plurality of wire or cable engaging attachments to the end portion of the fish tape.” These features have also been canceled from the claims, so the rejection is moot.

Rejection of Claims Under 35 U.S.C. § 112, second paragraph

Claims 1, 3, 11, 13, 19, and 21-23 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly failing the enablement requirement. The Office, in particular, finds no enablement for wires attached to the fish tape. The test of enablement is whether “undue experimentation” is needed to make or use the invention. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2164.01 (Rev. 1, Feb. 2003) (hereinafter “M.P.E.P.”). A specification that teaches an invention in terms which correspond in scope to the terms of the claims must be enabling. *See* M.P.E.P. at § 2164.04.

Again, though, the Assignee respectfully requests reconsideration of this rejection. The Office seems to have misinterpreted the teachings of the specification. The specification explains how “*the grooves 53 [in the end portion] provide a mechanism for attaching a plurality of wire or cable engaging attachments to the end portion 51 of the fish tape 54*” (emphasis added). *See* U.S. Application 10/786,733 at [0011], last sentence. The as-filed application thus explains how “engaging attachments” are attached to the pair of radially opposed grooves 53. The Office, however, mistakenly interprets this teaching to mistakenly request clarification of how “wires are to be attached to the fish tape such that the wires can be pulled by the fish tape.” The as-filed application explains how “engaging attachments” are attached to the grooves 53, not “wires” as the Office asserts. The Office’s interpretation is thus mistaken.

The Assignee may now answer the questions posed by the Office.

- 1) The Office asks if “a wire is somehow attached to the end portion?” “If so how?”

No, a wire is not attached to the end portion. The as-filed application explains how “engaging attachments” are attached to the grooves 53, not “wires” as the Office asserts. *See* U.S. Application 10/786,733 at [0011], last sentence. The Assignee thus respectfully requests removal of this rejection.

- 2) The Office asks is “it done by an attachment?” “If so how?”

The as-filed application explains how “engaging attachments” are attached to the grooves 53. *See* U.S. Application 10/786,733 at [0011], last sentence. However, the spiral groove and the “mechanism for attaching a plurality of wire or cable engaging attachments to the end portion of the fish tape” are not claimed as the invention, so the claims cannot be rejected for non-enablement of these features. The Assignee thus respectfully requests removal of this rejection.

- 3) The Office asks how “these grooves function in pulling a wire?”

The as-filed application explains how “engaging attachments” are attached to the grooves 53. *See* U.S. Application 10/786,733 at [0011], last sentence. However, the spiral groove and the “engaging attachments” are not claimed as the invention, so the claims cannot be rejected for non-enablement of these features. The Assignee thus respectfully requests removal of this rejection.

- 4) The Office asks “how does the spiral groove interact with the end groove?” “Do they intersect” “How does that impact the wires to be pulled by the grooves?”

The as-filed application explains that the spiral groove and the end groove are different embodiments (*see, e.g.*, FIGS. 5 and 8). As both the spiral groove and the end groove are not claimed as the invention, the claims cannot be rejected for non-enablement of these combined features. The Assignee thus respectfully requests removal of this rejection.

Rejection of Claims Under 35 U.S.C. § 103 (a)

Claims 1, 3, 11, 13, 19, and 21-23 were rejected under 35 U.S.C. § 103 (a) as allegedly being obvious over U.S. Patent 5,505,432 to Noonan in view of U.S. Patent 4,926,518 to Mikol and further in view of U.S. Patent 5,221,099 to Jansch.

The proposed combination of *Noonan*, *Mikol*, and *Jansch*, however, cannot obviate these claims. These claims recite, or incorporate, many features that are not disclosed or suggested by *Noonan*, *Mikol*, and *Jansch*. Independent claim 1, for example, recites “*each groove having a terminus at which the open slot terminates at a semi-circular end wall blending to the wider bottom floor.*” Support for such features may be found at least in the as-filed application at FIG. 5. Independent claims 11 and 19 recite similar features.

Noonan, *Mikol*, and *Jansch* cannot obviate all these features. *Noonan* describes a fish tape with an anti-snagging roller. *Mikol* discloses an auger for cleaning drains. *Jansch* describes a torque clamp having a dove-tail shaped tongue and groove. Still, though, the proposed combination of *Noonan*, *Mikol*, and *Jansch* fails to teach or suggest a dove-tail shaped tongue and groove that has “*a terminus at which the open slot terminates at a semi-circular end wall*” (emphasis added). Moreover, *Noonan*, *Mikol*, and *Jansch* also fail to teach or suggest “*blending to the wider bottom floor*” (emphasis added). Because the combined teaching of *Noonan*, *Mikol*, and *Jansch* fails to teach or suggest all these features, the independent claims cannot be obviated by *Noonan*, *Mikol*, and *Jansch*.

Claims 1, 3, 11, 13, 19, and 21-23, then, are not obvious. The independent claims recite many features that are not taught or suggested by *Noonan*, *Mikol*, and *Jansch*. The dependent claims incorporate these same distinguishing features. One of ordinary skill in the art, then, would not think that claims 1, 3, 11, 13, 19, and 21-23 are obvious. The Office is respectfully requested to remove the § 103 (a) rejection of these claims.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 469-2629 or scott@scottzimmerman.com.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Scott P. Zimmerman', with a stylized flourish at the end.

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